

Notice of Allowability	Application No.	Applicant(s)	
	10/001,469	JAKOBOVITS ET AL.	
	Examiner	Art Unit	
	MINH-TAM DAVIS	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 03/15/06.
2. ☒ The allowed claim(s) is/are 48, 50, 54, renumbered as 1-3.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>03/14/06</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>10/21/05</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT/COMMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with KATE MURASHIGE on 03/10/06.

The application has been amended as follows:

In the specification

The Related Applications on the first page of the specification were updated as follows:

This application claims benefit of priority from U.S. Provisional Application Serial Number 60/291,118, filed May 15, 2001, now abandoned, and is a continuation-in-part of U.S. Application Serial Number 09/680,728, filed October 5, 2000, now patented, US 6,790,631, which claims benefit of priority from U.S. Provisional Application Serial Number 60/1 57,902, filed October 5, 1999, now abandoned. All three of these applications are hereby incorporated in their entireties as if fully set forth.

2. In a telephonic interview of 03/14/06, Applicant agreed to amend claim 48 to delete "the downstream signaling effect thereof" to obviate the issue of 112, second and first paragraph, scope of said language. The Examiner takes note that in claim 48: 1) the added "101P3A11-mediated ERK phosphorylation" is supported on page 105, first and second paragraph, and figures 26-28, of the marked up copy of the substitute specification, submitted on

02/23/04, 2) the added "101P3A11-mediated p38 phosphorylation" is supported on page 105, last paragraph bridging p.106, and figure 31, 3) the added "101P3A11-mediated cell growth" is supported in Example 42, on page 108, last paragraph, bridging page 109, 4) the added "101P3A11-mediated G-alpha subunit activation" is supported on page 107, lines 17-26, and figure 35), and 5) the added "101P3A11-mediated cell adhesion" is supported in Example 45, on page 110.

The Examiner further takes note that in the marked-up copy of the substitute specification submitted on 02/23/04, the deleted sequences of Table XXVI, on pages 160-167, are duplicates of the sequences on pages 167-174. Similarly, the deleted sequences of Table XXVII, on pages 175-178, and of Table XXVIII, on pages 183-190 are duplicates of the sequences on pages 178-182, and 191-198, respectively.

3. The following is an examiner's statement of reasons for allowance:

The method claims 48, 50, 54 are novel and enabled, because of the following reasons:

1) The protein SEQ ID NO:2866 is novel and enabled, in view of the Declaration by Dr. Steven Kanner, submitted on 01/09/06, showing that a monoclonal antibody against SEQ ID NO:2866 decreases prostate cancer growth. Thus the claimed method to identify compounds that decreases the activity of SEQ ID NO:2866 is enabled, and

2) The closest prior art is the human P835P protein, SEQ ID NO:920, of US2002022248-A1, now patented, US 6,8000,746B2, which is 99.7% similar to SEQ ID NO:2866 of the instant application (MPSRCH search report, us-10-001-469a.2866.rag, page 10). SEQ ID NO:920 however is not enabled because although the art teaches the use of SEQ ID NO:920 for diagnosis and treating prostate cancer (columns 25-26), there is no data supporting,

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nor objective evidence indicating that SEQ ID NO:920 is overexpressed in prostate cancer, or correlated with prostate cancer. Further, the prior art does not teach that SEQ ID NO:920 has the activity of SEQ ID NO: 2866, i.e. mediating ERK phosphorylation, p38 phosphorylation, cell growth, G-alpha subunit activation, or cell adhesion, wherein such activity is used for screening an inhibitor of the protein activity.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


JEFFREY SIEW
SUPERVISORY PATENT EXAMINER

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS
March 17, 2006